



11 24-04

AF/362C1  
ITW

PATENT

Attorney Docket No.: 020375-006500US

"Express Mail" Label No. EV 470761530 US  
Date of Deposit November 22, 2004

I hereby certify that this is being deposited with the  
United States Postal Service "Express Mail Post Office to  
Address" service under 37 CFR 1.10 on the date indicated  
above and is addressed to:

**Mail Stop Appeal Brief - Patents**  
Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

By:

Bonnie Reckles

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES**

In re application of:

Jeffrey G. Nowlin et al.

Application No.: 10/028,888

Filed: December 19, 2001

For: **WEIGHT MEASURING SYSTEMS  
AND METHODS**

Examiner: Richard S. Woo

Art Unit: 3629

APPELLANTS' REPLY BRIEF UNDER 37  
CFR §41.41

Mail Stop Appeal Brief - Patents  
Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

Sir:

This Reply Brief is filed in response to the Examiner's Answer of October 26,  
2004.

ARGUMENT

In the Answer, the Examiner reiterated the rejection of all pending claims under 35 U.S.C. 102(b) as being anticipated by **Long** (EP 0,621,563). The Examiner stated that claim 15 is the broadest claim, and that **Long** discloses all the structural elements of claim 15. The Examiner further stated that **Long** is "capable of performing the intended use" recited by Applicants in functional limitations in claim 15.

Applicants respectfully disagree with the Examiner's statements.

First, **Long** is structurally different than Applicants' claimed invention. **Long** discloses data cards 32 that have a data record read by a reader 34 in order to (1) determine which inserts to include with the card (see col. 5, lines 42 through 56) and (2) later print certain information on a letter sheet to accompany the card (see col. 6, lines 6 through 23). The Examiner appears to state that Applicants' identifier is met by either (1) the data record on the card or (2) the information that is printed on the letter sheet.

Neither "identifier" in **Long** is the same as Applicants' identifier. Applicants' identifier is printed on a mailing component after it is provided to the system, and it is thereafter read for purposes of identifying inserts. In **Long**, the data record on the card is read by a reader 34, but such identifier is a data record on the card that is printed or stored before the card is provided to the system. The second "identifier" in **Long**, i.e., the information that is printed later in the system and on the letter sheet accompanying the card, is not read by any reader within the system, and is certainly not read to determine inserts.

The reader (27, 66) in **Long** that is referred to by the Examiner is a sensor used to determine the position of the paper, not to read an identifier (see col. 4, lines 42 through 46). The reader 34 in **Long** might be argued as analogous to Applicants' reader (even though not so argued by the Examiner), but it does not read an identifier printed within the system (i.e., "after" the mailing component "has been provided to the system", as in claim 15). Thus it is not possible for the **Long** structure to print an identifier that is subsequently read to determine mailing inserts. First, it would be impossible for the reader 34 to both read an identifier on the card and to also read an identifier that is subsequently printed on the sheet accompanying the

card. The reader 34 is not physically positioned to read both (it is located to read cards received from a card feeder, not read letter sheets). Secondly, the reader 34 must read the data record on the card in order to determine the information to be printed on the letter sheet, and thus logically it would make no sense (and there would be no reason) for it to read the data record on the card in order to determine information to be subsequently printed on a letter sheet, and then later also read the subsequently printed information on the letter sheet.

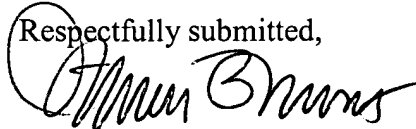
**Long** is not capable of performing the functions of Applicants' claimed invention. Applicants' functional limitations in claim 15 (i.e., a printer that prints an identifier on a mailing component "after that one of the components has been provided to the system, wherein the identifier is used to identify components of the mailing unit") are not inherent characteristics of the system disclosed in **Long**. Thus, **Long** does not disclose the claimed invention.

Further, the Examiner appears to argue that he may ignore the functional limitations recited by Applicants in claim 15. The Examiner states that this limitation is merely "a recitation of intended use". If the Examiner's reasoning were to be upheld by the Board, it would permit an Examiner to ignore any functional limitation as a "recitation of intended use". Applicants' definition of its printer is a definition of the element according to what it does functionally, rather than what it is structurally. Such recitation is proper. *In re Swinehart*, 439 F.2d 210, 169 USPQ 226 (CCPA 1971). Such a recitation may not be ignored by the Examiner. *In re Atwood*, 354 F.2d 365, 148 USPQ 203 (CCPA 1966).

Finally, Applicants believe the Examiner's statement that claim 15 is the broadest claim is not correct. Method claim 1 is as broad, if not broader, than claim 15. In claim 1, Applicants recite method steps without many of the structural limitations of claim 15. One of the method steps in claim 1 is "printing at the system an identifier on one of the components forming the mailing unit after that one of the components has been provided to the system, wherein the identifier may be used in identifying the components of the mailing unit." Such a limitation is clearly not found in **Long**.

Jeffrey G. Nowlin et al.  
Application No.: 10/028,888  
Page 4

Applicants believe all pending claims are in condition for allowance. It is respectfully requested that the Examiner's rejection of the claims be reversed.

Respectfully submitted,  
  
Stephen F. Jewett  
Reg. No. 27,565

TOWNSEND and TOWNSEND and CREW LLP  
Two Embarcadero Center, Eighth Floor  
San Francisco, California 94111-3834  
(303) 571-4000  
Fax (415) 576-0300  
SFJ/bhr  
60354151 v1



PTO/SB/21 (09-04)

**TRANSMITTAL  
FORM**

(to be used for all correspondence after initial filing)

Total Number of Pages in This Submission

1

Application Number

10/028,888

Filing Date

December 19, 2001

First Named Inventor

Nowlin, Jeffrey G.

Art Unit

3629

Examiner Name

Richard S. Woo

Attorney Docket Number

020375-006500US

**ENCLOSURES (Check all that apply)**☐

Fee Transmittal Form

☐

Fee Attached

☐

Amendment/Reply

☐

After Final

☐

Affidavits/declaration(s)

☐

Extension of Time Request

☐

Express Abandonment Request

☐

Information Disclosure Statement

☐

Drawing(s)

☐

Licensing-related Papers

☐

Petition

☐Petition to Convert to a  
Provisional Application☐Power of Attorney, Revocation  
Change of Correspondence Address☐

Terminal Disclaimer

☐

Request for Refund

☐

CD, Number of CD(s) \_\_\_\_\_

☐

Landscape Table on CD

☐

After Allowance Communication to TC

☒Appeal Communication to Board  
of Appeals and Interferences☐Appeal Communication to TC  
(Appeal Notice, Brief, Reply Brief)☐

Proprietary Information

☐

Status Letter

☒Other Enclosure(s) (please identify  
below):1. Appellants' Reply Brief under 37 CFR  
41.41

2. Return Postcard

☐Certified Copy of Priority  
Document(s)☐Reply to Missing Parts/ Incomplete  
Application☐Reply to Missing Parts  
under 37 CFR 1.52 or 1.53

Remarks

The Commissioner is authorized to charge any additional fees to Deposit  
Account 20-1430.**SIGNATURE OF APPLICANT, ATTORNEY, OR AGENT**

Firm Name

Townsend and Townsend and Crew LLP

Signature

Printed name

Stephen F. Jewett

Date

November 22, 2004

Reg. No.

27,565

**CERTIFICATE OF TRANSMISSION/MAILING**

Express Mail Label: EV 470761530 US

I hereby certify that this correspondence is being deposited with the United States Postal Service with "Express Mail Post Office to Address" service under 37 CFR 1.10 on this date **November 22, 2004** and is addressed to: Mail Stop Appeal Brief - Patents, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on the date shown below.

Signature

Typed or printed name

Bonnie Rickles

Date

November 22, 2004